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| APPLICATION NO.  | FILING DATE | FIRST NAMED INVENTOR       | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|--|-------------|----------------------------|---------------------|------------------|
| 10/575,334   | 05/22/2006  | Peter Marten Van Der Horst | ACM3020PIUS         | 3627             |
| 27624  | 7590        | 07/13/2010                 |                     |                  |
| AKZO NOBEL INC.<br>LEGAL & IP<br>120 WHITE PLAINS ROAD, SUITE 300<br>TARRYTOWN, NY 10591 |             |                            |                     |                  |
| EXAMINER   |             |                            |                     |                  |
| ADMASU, ATNAF S  |             |                            |                     |                  |
| ART UNIT   |             | PAPER NUMBER               |                     |                  |
| 1796   |             |                            |                     |                  |
| NOTIFICATION DATE  |             | DELIVERY MODE              |                     |                  |
| 07/13/2010   |             | ELECTRONIC                 |                     |                  |

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

IPANLPATENT@AKZONOBEL.COM

**Office Action Summary****Application No.**

10/575,334

**Applicant(s)**VAN DER HORST, PETER  
MARTEN**Examiner**

ATNAF ADMASU

**Art Unit**

1796

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 12 February 2010.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1,2,4 and 6-10 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,2,4 and 6-10 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

**DETAILED ACTION**

1. Claims 1, 2, 4 and 6-10 are pending as amended on 12 February 2010 and claims 3 and 5 being cancelled.
2. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 12 February 2010 has been entered.
3. The text of those sections of Title 35, US Code not included in this action can be found in a prior Office Action.

***Response to Amendment and Arguments***

4. Applicant's amendment to claim 1, filed 12 February 2010, specifying the degree of polymerization for 4 wt % CMC as less than 1,500 has been fully considered and overcome the following:

The rejection of claims 1 and its dependent claims 2, 4 and 6-10 under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention has been withdrawn.

5. Applicant's amendment to independent claim 1, filed 12 February 2010, requiring the gel reaches at least 60% of its gel strength within ten seconds of cessation of shear has been fully considered and overcome the following:

The rejection of claims 1, 2, 4 and 6-10 under 35 U.S.C. 103(a) as being unpatentable over US Patent Application Publication 2005/0031757 (Boevink hereinafter) in view of US Patent 6,281,172 (Warren hereinafter) has been withdrawn.

6. Applicant's further arguments, filed 12 February 2010, have been fully considered but they are not persuasive.

Applicant argues that the double patenting rejections are unfair because the use of a material in downhole drilling fluids cannot be an unfair extension of a monopoly on the same material in processed meats or fruit based products; however, the claims are to a composition and that a recitation of the intended use of the claimed invention must result in a structural (compositional) difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure (composition) is capable of performing the intended use, then it meets the claim.

### ***Double Patenting***

7. Claims 1, 2, 4 and 6 - 10 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-6 over copending application No. 10/537,199 in view of US Patent 6,281,172. Although the conflicting claims are not identical, they are not patentably distinct from each other because 11/537,199 and 11/575,334 are related to CMC composition, both comprising exact CMC composition would render the present claims obvious to one of ordinary skill in the art.

This is a provisional obviousness-type double patenting rejection.

8. Claims 1, 2, 4 and 6 - 10 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-6 of copending Application No. 10/490,998 in view of US Patent 6,281,172. Although the conflicting claims are not identical, they are not patentably distinct from each other because 11/490,998 and 11/575,334 are related to CMC composition, both comprising exact CMC composition would render the present claims obvious to one of ordinary skill in the art.

This is a provisional obviousness-type double patenting rejection.

### ***Conclusion***

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to ATNAF ADMASU whose telephone number is (571)270-5465. The examiner can normally be reached on M-F 8:00-5:30, Flexible Schedule.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Harold Pyon can be reached on 571-272-1498. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/ASA/  
Atnaf Admasu  
Art Unit 1796  
July 3, 2010

/Timothy J. Kugel/  
Primary Examiner, Art Unit 1796